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| 09/655,252      | 09/05/2000  | Lee Cannon           | 100-114P2           | 7732             |

7590 08/15/2003  
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EXAMINER

COBURN, CORBETT B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3714

DATE MAILED: 08/15/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/655,252

Applicant(s)

CANNON ET AL.

Examiner

Corbett B. Coburn

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 48-126 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-126 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 15 January 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Claim Objections*

1. Claim 49 is objected to because of the following informalities: It contains the limitation "at one reel display." A word appears to be missing or wrong. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 65, 66, 99 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the function of the secondary gaming unit and the randomly generated indicia displayed thereon. The secondary gaming unit evidently generates and displays a random indicia, but what does it do with it afterwards? Does this indicia have any effect on the game? Or is it merely a decorative device intended to add visual interest?

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 48-126 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly et al. (US Patent Number 5,816,918).

<sup>48</sup>  
Claims ~~1~~, 84: Kelly teaches 48. (New) A gaming device (10) with a currency receiver (14) being adapted to receive at least one medium of currency and a display device (56) being adapted to display indicia corresponding to an outcome of a wagering game (i.e., poker, blackjack, solitaire – Col 1, 28-29). The outcome of an occurrence of the wagering game is at least partially randomly determined. A player of the gaming device is provided with a gaming award based on the occurrence of a predetermined outcome during the occurrence of the wagering game after depositing at least a minimum amount of the at least one medium of currency in the currency receiver (Abstract). There is a first output device (20) being adapted to dispense a ticket after the occurrence of a triggering event – player operation of the “Collect Prize” button (286). The triggering event is not the occurrence of a predetermined outcome of the wagering game wherein the player is provided with a gaming award, and wherein the triggering event is not every occurrence of the wagering game. The triggering event is the operation of the “Collect Prize” button (286) by the player.

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**Claim 49:** Kelly teaches that the system may be applied to slot machines. (Col 3, 44)

Slot machines have at least one reel display.

**Claim 50:** Fig 2 clearly shows that display device (56) is a video display.

**Claims 51, 85:** Specific Prize Ticket Dispenser (22) is a second output device being adapted to dispense the gaming award, the second output device being operable independent of the first output device.

**Claim 52:** The first output device (20) is a ticket dispenser.

**Claims 59, 92, 93:** Kelly teaches the use of smart cards and user validation/verification. (Col 6, 46-56) This is equivalent to a user tracking card.

**Claims 60, 94:** Kelly teaches the tickets dispensed by the first output device may be promotional tickets. (Col 8, 61-63)

**Claims 61, 95:** Kelly teaches the tickets dispensed by the first output device may be redeemable for one occurrence of the wagering game. (Col 8, 60)

**Claims 62, 96:** Kelly teaches that prizes are “any merchandise, souvenir, food item, or other physical goods or services which can be offered to players”. (Col 8, 55-56) Kelly specifically teaches that a free game is a prize. (Col 8, 60) An occurrence of a second wagering game on a second gaming device is a service that can be offered to players.

Therefore, Kelly teaches the tickets dispensed by the first output device may be redeemable for one occurrence of a second wagering game on a second gaming device.

**Claims 63, 97:** Kelly teaches that prizes are “any merchandise, souvenir, food item, or other physical goods or services which can be offered to players”. (Col 8, 55-56) Thus,

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the tickets dispensed by the first output device are redeemable for services provided by a gaming establishment.

**Claims 78, 111:** Kelly teaches that the tickets are redeemable for prizes. Thus, the tickets are different in form from the gaming award. Furthermore, Kelly teaches that the game award may take the form of cash issued by the machine. (Col 8, 7-9) This is different in form than the tickets issued.

**Claim 79:** The first output device comprises a printer. (Col 10, 30-35)

**Claims 80, 112:** Fig 2 shows the printer prints indicia corresponding to at least one of a plurality of signals generated at a location remote from the gaming device. In this case, the printer (50) is remote from the game device (10).

**Claims 81, 113:** The plurality of signals are generated by a gaming establishment. The game machine (10) generates the signals and it belongs to a gaming establishment.

**Claims 82, 83, 114, 115:** Kelly teaches the plurality of signals are generated in direct response to operator input -- operation of the "Collect Prize" button (286) by the player.

**Claim 116:** Kelly teaches providing a player with an opportunity to place a wager and to play the wagering game at the wagering device, wherein the outcome of each occurrence of the wagering game is at least partially randomly determined. (Abstract) Kelly teaches accumulating points for the player as the player plays the wagering game and displaying a visible indication (125) of the player's accumulated points at the gaming device and providing the player with the opportunity to redeem at least a portion of the accumulated points at the gaming device via an input device. (Abstract) Kelly also teaches that the

gaming device may be used for promotional uses – i.e., comps. (Col 6, 61-63) In that situation, the points accumulated by the player would be comp points.

**Claims 117, 121:** Kelly teaches displaying at least one redemption option to a player at the gaming device. (Fig 6b)

**Claim 118:** Fig 6b shows highlighting one of the prizes and checking a box. This is changing the display of the at least one redemption option of the gaming device.

**Claim 119:** A player has to provide input in order to play the game and accumulate comp points. Thus player input at the gaming device is required prior to displaying the player's accumulated comp points.

**Claim 120:** In order to redeem points, the player must provide input to make a selection of the prize. (Fig 6b)

**Claim 122:** Kelly teaches printing tickets redeemable for goods and services. (Col 8, 55-56)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 53-55, 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly as applied to Claim 48, 84 in view of Seibert, Jr. et al. (US Patent Number 5,785,594)

**Claims 53-55:** Kelly teaches the invention substantially as claimed but does not specifically teach the triggering event being a predetermined outcome of the wagering

game that does not result in providing a gaming award. Seibert teaches printing tickets as a consolation prize when the outcome of the wagering game that does not result in providing a gaming award. (Col 8, 53-55) Since the consolation prize is issued whenever the player fails to win, the ticket is issued after a predetermined number (one) of occurrences of the wagering game in which the outcomes of the occurrences of the wagering game do not result in providing a gaming award. Also since the consolation prize is issued whenever the player loses, the triggering event is the loss of a predetermined number of games (one) within a predetermined time period – the time taken to play a game.

Consolation prizes are well known to the art and are used to maintain player interest even though the player loses the game. It would have been obvious to one of ordinary skill in the art to have the triggering event be a predetermined outcome of the wagering game that does not result in providing a gaming award in order to award consolation prizes that maintain player interest even though the player loses the game.

8. Claims 56 & 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly as applied to claim 48 or 84 above, and further in view of Fey (*Slot Machines*, page 162).

**Claims 56 & 89:** Kelly teaches the invention substantially as claimed, but does not teach the triggering event being a predetermined number of occurrences of a wagering game. On page 162, Fey discloses the Mills Futurity machine that pays off if the player hasn't won in 10 games. Fey teaches that this keeps the player from getting discouraged and quitting the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have triggering event be a predetermined number of occurrences



of a wagering game in order to keep the player from getting discouraged and quitting the game.

9. Claims 57, 58, 90 & 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly as applied to claim 48 or 84 above, and further in view of Harlick (US Patent Number 5,941,773).

**Claims 57, 58, 90 & 91:** Kelly teaches the invention substantially as claimed but does not teach the triggering event being a randomly determined occurrence of a wagering game or a randomly determined time. Harlick teaches awarding a bonus based on a randomly determined occurrence of a wagering game (Fig 2) or a randomly determined time (Fig 3). Harlick teaches that this scheme will induce players to play the games. (Col 1, 9-10). It would have been obvious to one of ordinary skill in the art at the time of the invention to have the triggering event be a randomly determined occurrence of a wagering game or a randomly determined time in order to induce players to play the game.

10. Claims 64, 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly as applied to claim 48, 84 above, and further in view of Harrison (US Patent Number 5,934,671).

**Claims 64, 98:** Kelly teaches the invention substantially as claimed but does not teach the award of scratch-off tickets. Harrison teaches scratch-off tickets. Scratch-off tickets are well known to the art and are often used as promotional tickets. Having a scratch-off ticket prolongs the player interest in the game because it adds another step to the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to

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have issued Kelly's promotional tickets in the form of Harrison's scratch-off ticket in order to prolong the player interest in the game by adding another step to the game.

11. Claims 65, 66, 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly as applied to claim 48 above, and further in view of Baerlocher et al. (US Patent number 5,788,573).

**Claims 65, 66, 99:** Kelly teaches the invention substantially as claimed, but does not teach a secondary gaming unit with a wheel to display randomly generated indicia. Baerlocher teaches use of a secondary gaming unit in the form of a wheel to display randomly generated indicia. (Fig 4) Such "wheels of fortune" are common to the art and are often used to display randomly generated indicia. These displays add visual interest to the gaming device. It would have been obvious to one of ordinary skill in the art to have a secondary display in the form of a wheel to display randomly generated indicia in order to add visual interest to the gaming device.

12. Claims 67-77, 100-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly as applied to claim 48 above, and further in view of Mullins (US Patent Number 5,158,293).

**Claims 67-70:** Kelly teaches the invention substantially as claimed. Kelly teaches dispensing a ticket that can be redeemed for prizes upon the occurrence of a triggering event -- the operation of the "Collect Prize" button (286) by the player. Kelly teaches that prizes are "any merchandise, souvenir, food item, or other physical goods or services which can be offered to players". (Col 8, 55-56) Kelly also teaches that tickets may be redeemed for a free game. (Col 8, 60) Kelly does not, however, specifically teach that

the ticket may also be redeemed for an entry in a drawing, though such a ticket would be within Kelly's definition of a prize. Mullins teaches a lottery ticket that may be used in a drawing. Lotteries are extremely popular with both players and casinos. Players find lotteries exciting for the same reason casinos like them -- lotteries can offer large prizes. However, some players prefer a certain payout since lotteries have such poor odds of winning. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the tickets be redeemable for one occurrence of the wagering game and entries in a drawing in order to take advantage of the popularity of lotteries while, at the same time giving the player a certain payout in the form of a free game.

**Claims 71, 74, 104:** Mullins teaches an embodiment with means for receiving a player's selection of at least one indicia from a predetermined set of indicia for the drawing. (Col 5, 12-15)

**Claims 72, 105:** Mullins teaches randomly selecting the indicia. (Col 3, 59-61)

**Claims 73, 106:** Mullins teaches that the indicia are numbers. (Col 3, 59-61)

**Claims 75, 108:** Mullins teaches allowing the player to choose indicia for a drawing-type lottery. (Col 5, 12-15) Mullins is silent concerning how these indicia are entered into the device. Keypads are well-known devices for data entry. Kelly teaches a keyboard input device. (Col 7, 4-9) A keyboard is a keypad.

**Claims 76, 109:** Kelly teaches a touch screen input device. (Col 7, 7)

**Claims 77, 110:** Mullins teaches that the indicia are numbers. (Fig 5)

13. Claims 123-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly as applied to claim 116 above, and further in view of Boushy (US Patent Number 5,761,647).

**Claims 123-126:** Kelly teaches the invention substantially as claimed. Kelly teaches allowing the player to accumulate comp points, but does not go into the details. Boushy teaches accumulating a plurality of comp values according to different comp criteria. (Col 5, 16-19) The comp values have corresponding comp awards. (I.e., The player gets more points for certain activities.) The player may continue to accumulate points even after the player has reached a comp value level that qualifies for an award.

All activities that are eligible for “comping” get an award of comp points for the player. As pointed out at Boushy’s Col 5, 16-19, some activities earn a larger award than others. Whenever a player participates in any of these activities, the player receives comp points – even if the player has already had an award of comp points.

“Comping” is well known to the art. It is a method of attracting repeat players and for awarding players non-monetary awards -- both of which increase casino profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have taken Kelly’s suggestion of awarding comps and fleshed it out using Boushy’s disclosure in order to have a complete comping system that attracts repeat players and for awards players non-monetary awards, thus increasing casino profits.

***Information Disclosure Statement***

14. Examiner had carefully considered the Declaration of Mr. Chilton.

The declaration under 37 CFR 1.132 filed on 15 July 2003 is insufficient to overcome the rejection of claims 48-126 based upon Kelly as set forth in the last Office action because: It refer(s) only to the system described in the above referenced application and not to the individual

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claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

***Response to Arguments***

15. No arguments were presented.

***Conclusion***

16. This is an RCE of applicant's earlier Application No. 09/655252. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

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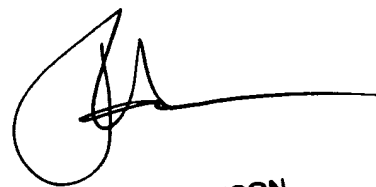
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



cbe

August 7, 2003



JESSICA HARRISON  
PRIMARY EXAMINER